

U.S. Patent Appln. No. 10/660,964  
Amendment  
Response to Office Action of January 14, 2005

Docket No. 6834-1-3

### REMARKS

The foregoing amendments and these remarks are in response to the Office Action dated January 14, 2005. This amendment is accompanied by a request for extension of time.

Applicant appreciates the claim renumbering carried out by the Examiner, and has adhered to the correct numbering herein.

At the time of the Office Action, claims 1-28 were pending. In the Office Action, claims 19 and 20 were rejected under 35 U.S.C. §112, second paragraph. Claims 1-28 were rejected under 35 U.S.C. §103(a). Claims 1, 3-26 and 28 were rejected under the judicially created doctrine of double patenting. The objections and rejections are set forth in more detail below.

#### I. Rejections under 35 U.S.C. §112, second paragraph

Claims 19 and 20 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, claim 19 was rejected for repeating a limitation previously claimed in claim 1. Claim 20 was rejected because it was alleged to contradict the limitation of claim 1. Claim 19 is cancelled herein. Claim 20 is not believed to be contradictory with claim 1, but nevertheless claim 1 is amended to recite that the sole has a generally smooth outer surface, and claim 20 recites that at least a portion of the sole has a surface pattern. A surface pattern does not imply that the sole has deep ridges or patterning, and it is believed that a shallow surface ridging or patterning is not inconsistent with the sole being generally smooth. Withdrawal of the rejections under §112 are respectfully requested, for the reasons given.

#### II. Rejections on Art

Claims 1, 3, 4, 7-26 and 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,703,775 to Gatti in view of U.S. Patent No. 4,377,913 to Stone and U.S. Patent No. 3,583,081 to Hayashi. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gatti, Stone and Hayashi, and further in view of U.S. Patent No. 3,650,051 to Sass. Claims 5 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gatti, Stone and Hayashi, and further in view of U.S. Patent No. 3,284,931 to Dassler. Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over Gatti, Stone and Hayashi, and further in view of U.S. Patent No. 830,753 to Voss.

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Claim 1 is amended herein to recite that the inner tongue portion is padded. Gatti relates to a soccer shoe having a reinforced shield 4 and an inner tongue 11. There is no teaching or suggestion in Gatti that the inner tongue 11 is padded. A first fastening structure 17 is provided underneath the reinforced shield 4. Second and third fastening structures 8, 9, 16 are positioned at the side of the shoe to hold the shield in place. The second and third fastening structures are not covered by the shield, and would therefore impact any person or object kicked by a wearer while wearing the shoe. In addition, the outer tongue portion is reinforced on its outer side, and therefore a target would not be protected from impact with the shoe.

Dassler relates to a one-piece tongue having a padded central portion and does not teach or suggest a two-piece tongue portion having fastening structure positioned between an inner padded tongue portion and an outer padded tongue portion and which is covered by the outer tongue portion.

Hayashi relates to padding material placed in the shoe upper and does not teach or suggest a two-piece tongue portion having fastening structure positioned between inner and outer tongue portions and which is covered by the outer tongue portion.

Thus, even if the references were combined, there is no teaching or suggestion in any of them to provide a two-piece padded tongue portion wherein the inner and outer tongue portions are both padded. The claims are thus believed to be patentable over the cited prior art.

### III. Double patenting rejection

Claims 1, 3-26 and 28 were rejected under the judicially created doctrine of double patenting over claims 1-21 of U.S. Patent No. 6,408,542. Claim 2 was rejected under the judicially created doctrine of double patenting over claims 1-21 of U.S. Patent No. 6,408,542 in view of Sass. Claim 27 was rejected under the judicially created doctrine of double patenting over claims 1-21 of U.S. Patent No. 6,408,542 in view of Voss. A terminal disclaimer is filed herewith to overcome these rejections, withdrawal of which is respectfully requested.

### IV. Conclusion

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. Nevertheless, Applicant invites

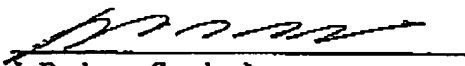
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the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. In view of the foregoing remarks, Applicant respectfully requests reconsideration and prompt allowance of the pending claims.

Respectfully submitted,

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